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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,748	07/02/2003	Thomas J. Bate	10253/12	5661
757	7590	04/08/2005		
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
			EXAMINER ZACHARIA, RAMSEY E	
			ART UNIT 1773	PAPER NUMBER
DATE MAILED: 04/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,748

Applicant(s)

BATE, THOMAS J.

Examiner

Ramsey Zacharia

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 35-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 1, 6, 8, 13, 35, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Okuda et al. (U.S. Patent 6,183,869).

Okuda et al. teach a primer layer which is applied on a substrate column 3, lines 17-30). The primer is composed of a silane coupling agent, a heat resistant resin, and fluororesin (column 6, lines 25-30). The heat resistant resin may be polyamideimide or polyether sulfone (column 7, lines 13-21). The ratio of heat resistant resin to fluororesin ranges from 10:90 to 90:10, a range that includes values of about 1:4 (column 9, lines 3-6). Iron oxide, a conductive pigment, may also be added to the primer layer which is heated after application (column 22, lines 58-65).

Claim Rejections - 35 USC § 103

3. Claims 1, 6-8, 13, 14, 35, 40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuda et al. (U.S. Patent 6,183,869).

Okuda et al. teach a primer layer which is applied on a substrate column 3, lines 17-30). The primer is composed of a silane coupling agent, a heat resistant resin, and fluororesin (column 6, lines 25-30). The heat resistant resin may be polyamideimide or polyether sulfone

Art Unit: 1773

(column 7, lines 13-21). Iron oxide, a conductive pigment, may also be added to the primer layer which is heated after application (column 22, lines 58-65).

The ratio of heat resistant resin to fluororesin ranges from 10:90 to 90:10, a range that includes values of about 1:4 (column 9, lines 3-6). In the event that the use of 1 part by weight heat resistant resin to 4 parts by weight fluororesin is not readily envisaged by one skilled in the art, it would be obvious to select any value from the disclosed range, including a ratio of about 1:4.

Regarding claims 7, 14, and 45, it would be obvious to one skilled in the art to add a black pigment to the primer layer for aesthetic reasons in applications in which it is desired to have a black primer since the addition of pigments to polymer systems is well within the ability of one skilled in the art.

4. Claims 2-5, 9-12, 36-39, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuda et al. (U.S. Patent 6,183,869) in view of Gebauer (U.S. Patent 4,546,141).

Okuda et al. teach all the limitations of claims 2-5 and 9-12 as outlined above except that the PFA of Okuda et al. is a genus (tetrafluoroethylene/perfluoroalkylvinyl ether) of the MFA and PFA of the instant invention.

Gebauer is directed to a primer comprising a mixture of a copolymer of tetrafluoroethylene and perfluoroalkylvinyl ether and a resin such as polyether sulfone (abstract). The alkyl group of the perfluoroalkylvinyl ether unit is a perfluoroalkyl radical having 1 to 10 carbon atoms (column 2, lines 58-62). When the perfluoroalkyl radical has 1 carbon atom, the

Art Unit: 1773

resulting copolymer is "MFA" as described in the instant invention. When the perfluoroalkyl radical has 3 carbon atoms, the resulting copolymer is "PFA" as described in the instant invention.

Gebauer shows that perfluoroalkyl radicals having 1 to 10 carbon atoms are known in the art as functionally equivalent for tetrafluoroethylene/perfluoroalkyl vinyl ether copolymer used in primer systems. Therefore, because these perfluoroalkyl groups were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to use perfluoroalkyl groups having 1 or 3 carbon atoms in the copolymer of tetrafluoroethylene and perfluoroalkylvinyl ether of Okuda et al.

Response to Arguments

5. Applicant's arguments filed 19 January 2005 have been fully considered but they are not persuasive.

The applicant argues that the primer of Okuda et al. is not a single coat that comprises a components (a), (b), and (c), but rather a two part primer composition that is applied as two coats.

This is not persuasive because Okuda et al. do not teach that their primer must be a two-part composition applied as two coats. Rather, Okuda et al. teach that "[t]he first primer composition of the present invention is a composition comprising at least a fluoro-resin, coupling agent, and heat resistant resin" (see column 6, lines 25-27). While Okuda et al. do teach a two-part primer, this is merely a preferred embodiment. The teachings of a references are not limited to preferred embodiment(s). Rather, a reference may be relied upon for all that it would have

Art Unit: 1773

reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments.

See MPEP § 2123. One skilled in the art would have readily envisaged primer compositions outside the narrow, preferred embodiment disclosed to include single compositions provided that they contained at least a fluoro-resin, coupling agent, and heat resistant resin.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsay Zacharia
Primary Examiner
Tech Center 1700